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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,500	09/15/2003	Yuji Sato	117176	7403

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EXAMINER	
MILIA, MARK R	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,500	SATO ET AL.	
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/29/07 and has been entered and made of record. Currently, claims 1-18 are pending.

Claim Rejections - 35 USC § 101

2. Applicant's amendment to claims 12 and 13 has overcome the rejection set forth in the previous Office Action and therefore the rejection has been withdrawn.

Response to Arguments

3. Applicant's arguments, see pages 9-11 of the remarks, filed 10/29/07, with respect to the rejection(s) of claim(s) 1-18 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 5, 6, 11, 12, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,143,141 to Morgan et al. in view of U.S. Patent Application Publication No. 2002/0024686 to Uchiyama et al.

Regarding claim 1, Morgan discloses an image forming apparatus connectable to a WAN and a LAN and capable of conducting a bidirectional communication with each terminal in the WAN or the LAN (see column 3 lines 22-30), comprising: an image forming unit configured to form an image based on externally input data on a recording medium (see column 8 lines 17-25), a substitutional sending/receiving unit configured to send a request signal to a web server in the WAN upon reception of a request signal for web server from a LAN terminal in the LAN, and configured to receive content data sent from the web server as a response signal to the request signal (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a transfer unit configured to send the content data received by the substitutional sending/receiving unit to the LAN terminal that has sent the request signal for web server (see Figs. 1 and 5, column 3 lines 40-52, column 5 lines 23-27, and column 6 lines 38-54), an image formation requesting unit that causes the image forming unit to form an image based on the content data received by the substitutional sending/receiving unit by inputting the content data to the image forming unit (see

column 8 lines 17-25), and a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Morgan does not disclose expressly a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the image formation requesting unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal.

Uchiyama discloses a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the image formation requesting unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal (see paragraphs 139-144).

Regarding claim 11, Morgan discloses an image forming apparatus connectable to a WAN and a LAN and capable of conducting a bidirectional communication with each terminal in the WAN or the LAN, comprising: an image forming unit configured to form an image based on externally input data on a recording medium (see column 8 lines 17-25), and a communication control unit including a gateway unit and a wireless processing unit (see column 5 lines 3-11), wherein the gateway unit comprises: a substitutional sending/receiving unit configured to send a request signal to a web server in the WAN upon reception of a request signal for web server from a LAN terminal in the

LAN, and configured to receive content data sent from the web server as a response signal to the request signal (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a transfer unit configured to send the content data received by the substitutional sending/receiving unit to the LAN terminal that has sent the request signal for web server (see Figs. 1 and 5, column 3 lines 40-52, column 5 lines 23-27, and column 6 lines 38-54), an image formation requesting unit that causes the image forming unit to form an image based on the content data received by the substitutional sending/receiving unit by inputting the content data to the image forming unit (see column 8 lines 17-25), and a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Morgan does not disclose expressly a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the image formation requesting unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal.

Uchiyama discloses a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause

the image formation requesting unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal (see paragraphs 139-144).

Regarding claim 12, Morgan discloses a program product for causing an image forming apparatus that is connectable to a WAN and a LAN, capable of conducting a bidirectional communication with each terminal in the WAN or the LAN and including an image forming unit configured to form an image based on externally input data on a recording medium to execute procedures, comprising: a substitutional sending unit that sends a request signal to a web server in the WAN upon reception of a request signal for web server from a LAN terminal in the LAN (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a substitutional receiving unit that receives content data sent from the web server as a response signal to the request signal (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a transferring unit that transfers the content data received by the substitutional receiving unit to the LAN terminal that has sent the request signal for web server when judging that the content data is suitable for the capabilities of the LAN terminal (see Figs. 1 and 5, column 3 lines 40-52, column 5 lines 23-27, column 6 lines 38-54, and column 8 lines 6-16), and a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Morgan does not disclose expressly a requesting unit that requests to form an image based on the content data by inputting the content data to the image forming unit when judging that the content data is not suitable for capabilities of the LAN terminal.

Uchiyama discloses a requesting unit that requests to form an image based on the content data by inputting the content data to the image forming unit when judging that the content data is not suitable for capabilities of the LAN terminal (see paragraphs 139-144).

Regarding claim 14, Morgan discloses an image forming apparatus connectable to a WAN and a LAN and capable of conducting a bidirectional communication with each terminal in the WAN or the LAN, comprising: an image forming unit configured to form an image based on externally input data on a recording medium (see column 8 lines 17-25), a substitutional sending/receiving unit configured to send a request signal to a web server in the WAN upon reception of a request signal for web server from a LAN terminal in the LAN, and configured to receive content data sent from the web server as a response signal to the request signal (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a transfer unit configured to send the content data received by the substitutional sending/receiving unit to the LAN terminal that has sent the request signal for web server (see Figs. 1 and 5, column 3 lines 40-52, column 5 lines 23-27, and column 6 lines 38-54), and a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Morgan does not disclose expressly a data writing unit configured to write the content data received by the substitutional sending/receiving unit to a recording medium for data storage and a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the

LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the data writing unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal.

Uchiyama discloses a data writing unit configured to write the content data received by the substitutional sending/receiving unit to a recording medium for data storage (see paragraph 139) and a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the data writing unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal (see paragraphs 139-144).

Regarding claim 18, Morgan discloses an image forming apparatus connectable to a WAN and a LAN and capable of conducting a bidirectional communication with each terminal in the WAN or the LAN, comprising: an image forming unit configured to form an image based on externally input data on a recording medium (see column 8 lines 17-25), a substitutional sending/receiving unit configured to send a request signal to a web server in the WAN upon reception of a request signal for web server from a LAN terminal in the LAN, and configured to receive content data sent from the web server as a response signal to the request signal (see Fig. 1, column 3 lines 15-18, 34-36, and 40-52, column 4 lines 13-20 and 39-46, and column 7 lines 18-60), a transfer unit configured to send the content data received by the substitutional sending/receiving

unit to the LAN terminal that has sent the request signal for web server (see Figs. 1 and 5, column 3 lines 40-52, column 5 lines 23-27, and column 6 lines 38-54), and a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Morgan does not disclose expressly an announcing unit configured to announce that the content data received by the substitutional sending/receiving unit is not suitable for the capabilities of the LAN terminal and a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal; and configured to cause the announcing unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal.

Uchiyama discloses an announcing unit configured to announce that the content data received by the substitutional sending/receiving unit is not suitable for the capabilities of the LAN terminal (see paragraphs 143-144) and a switching unit configured to judge whether the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal, configured to cause the transfer unit to operate when judging that the content data is suitable for the capabilities of the LAN terminal, and configured to cause the announcing unit to operate when judging that the content data is not suitable for the capabilities of the LAN terminal (see paragraphs 139-144).

Morgan & Uchiyama are combinable because they are from a similar field of endeavor, display or printing of received image content.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine switching the way data is processed based on capabilities of a terminal device, as described by Uchiyama, with the system of Morgan to allow switching between rendering modules. Switches are well known and commonly used in the art and therefore it would have been obvious to have a switching unit between rendering modules, such as the display and print modules, to allow a user to obtain information even if a user does not have a display with a sufficient capability.

The suggestion/motivation for doing so would have been to allow a user to obtain information even if a user does not have a display with a sufficient capability.

Therefore, it would have been obvious to combine Uchiyama with Morgan to obtain the invention as specified in claims 1, 11, 12, 14, and 18.

Regarding claim 5, Morgan does not disclose expressly further comprising a data writing unit for writing the content data received by the substitutional sending/receiving unit to a recording medium for data storage, wherein the switching unit selectively causes the image formation requesting unit or the data writing unit to operate depending on a type of the content data when judging that the content data is not suitable for the capabilities of the LAN terminal that has sent the request signal for web server.

Uchiyama discloses a data writing unit for writing the content data received by the substitutional sending/receiving unit to a recording medium for data storage,

wherein the switching unit selectively causes the image formation requesting unit or the data writing unit to operate depending on a type of the content data when judging that the content data is not suitable for the capabilities of the LAN terminal that has sent the request signal for web server (see paragraphs 139-144).

Regarding claim 6, Morgan further discloses wherein the image forming unit is configured to print an image based on externally input data on a recording sheet (see column 8 lines 6-16).

6. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan and Uchiyama as applied to claims 1 and 12 above, and further in view of Kinoshita (US 2003/0053122).

Regarding claims 2 and 13, Morgan and Uchiyama do not disclose expressly wherein the image formation requesting unit sends the LAN terminal a message inquiring whether to cause the image forming unit to form an image based on the content data received by the substitutional sending/receiving unit, and inputs the content data received by the substitutional sending/receiving unit to the image forming unit when receiving an image formation instruction signal from the LAN terminal as a response to the message.

Kinoshita discloses wherein the image formation requesting unit sends the LAN terminal a message inquiring whether to cause the image forming unit to form an image based on the content data received by the substitutional sending/receiving unit, and inputs the content data received by the substitutional sending/receiving unit to the

image forming unit when receiving an image formation instruction signal from the LAN terminal as a response to the message (see Figs. 5 and 6 and paragraphs 36-45).

Morgan, Uchiyama, & Kinoshita are combinable because they are from a similar field of endeavor, display or printing of received image content.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the image formation request and response to print content, as described by Kinoshita, with the system of Morgan and Uchiyama.

The suggestion/motivation for doing so would have been to allow a user to obtain information even if a user does not have a display with a sufficient capability.

Therefore, it would have been obvious to combine Kinoshita with Morgan and Uchiyama to obtain the invention as specified in claims 2 and 13.

7. Claims 3-4, 7-10, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan and Uchiyama as applied to claims 1 and 14 above, and further in view of Yamaguchi (JP 2001-236288).

Regarding claims 3 and 16, Morgan discloses a plurality of rendering modules that function to print or display retrieved content (see column 8 lines 6-16).

Uchiyama discloses wherein the switching unit judges whether the content data received by the substitutional sending/receiving unit is suitable for the capabilities of the LAN terminal that has sent the request signal for web server on the basis of the information relating to capabilities of each LAN terminal stored in the database (see paragraphs 139-144).

Morgan and Uchiyama do not disclose expressly a database for storing information relating to capabilities of each LAN terminal in the LAN.

Yamaguchi discloses a database for storing information relating to capabilities of each LAN terminal in the LAN (see paragraphs 22, 35-37, and 39-40).

Regarding claim 7, Morgan and Uchiyama do not disclose expressly wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when an image size of image data contained in the content data is within a screen size of a display unit of the LAN terminal.

Yamaguchi discloses wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when an image size of image data contained in the content data is within a screen size of a display unit of the LAN terminal (see paragraphs 35-37).

Regarding claim 8, Morgan and Uchiyama do not disclose expressly wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when an image size of image data contained in the content data is within a screen size of a display unit of the LAN terminal.

Yamaguchi discloses wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when an image size of image data contained in the content data is within a screen size of a display unit of the LAN terminal (see paragraphs 35-37).

Regarding claim 9, Morgan and Uchiyama do not disclose expressly wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when a display unit of the LAN terminal is capable of displaying image data that is color data or monochrome data and is contained in the content data.

Yamaguchi discloses wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when a display unit of the LAN terminal is capable of displaying image data that is color data or monochrome data and is contained in the content data (see paragraphs 35-37).

Regarding claim 10, Morgan and Uchiyama do not disclose expressly wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when a format of image data contained in the content data is extractable in the LAN terminal.

Yamaguchi discloses wherein the switching unit judges that the content data received by the substitutional sending/receiving unit is suitable for capabilities of the LAN terminal when a format of image data contained in the content data is extractable in the LAN terminal (see paragraphs 35-37).

Morgan, Uchiyama, & Yamaguchi are combinable because they are from a similar field of endeavor, display or printing of received image content.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the database for storing information relating to capabilities, as

described by Yamaguchi, with the system of Morgan and Uchiyama to allow switching between rendering modules. Switches are well known and commonly used in the art and therefore it would have been obvious to have a switching unit between rendering modules, such as the display and print modules, to allow a user to obtain information even if a user does not have a display with a sufficient capability.

The suggestion/motivation for doing so would have been to allow a user to obtain information even if a user does not have a display with a sufficient capability.

Therefore, it would have been obvious to combine Yamaguchi with Morgan and Uchiyama to obtain the invention as specified in claims 3 and 7-10.

Regarding claims 4 and 17, Yamaguchi further discloses a registering unit configured to judge whether information relating to the capabilities of the LAN terminal that has sent the request signal for web server is registered in the database, and configured to acquire information relating to the capabilities of the LAN terminal from the LAN terminal and register the information in the database when judging that the information is not registered in the database (see paragraphs 36-40).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan and Uchiyama as applied to claim 14 above, and further in view of Kinoshita (US 2003/0053122).

Morgan and Uchiyama do not disclose expressly wherein the data writing unit sends the LAN terminal a message inquiring whether to write the content data received

by the substitutional sending/receiving unit to the recording medium for data storage, and writes the content data to the recording medium for data storage when receiving an image formation instruction signal from the LAN terminal as a response to the message.

Kinoshita further discloses wherein the data writing unit sends the LAN terminal a message inquiring whether to write the content data received by the substitutional sending/receiving unit to the recording medium for data storage, and writes the content data to the recording medium for data storage when receiving an image formation instruction signal from the LAN terminal as a response to the message (see paragraph 42).

Morgan, Uchiyama, & Kinoshita are combinable because they are from a similar field of endeavor, display or printing of received image content.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the data writing unit, as described by Kinoshita, with the system of Morgan and Uchiyama to allow switching between rendering modules. Switches are well known and commonly used in the art and therefore it would have been obvious to have a switching unit between rendering modules, such as the display and print modules, to allow a user to obtain information even if a user does not have a display with a sufficient capability.

The suggestion/motivation for doing so would have been to allow a user to obtain information even if a user does not have a display with a sufficient capability.

Therefore, it would have been obvious to combine Kinoshita with Morgan and Uchiyama to obtain the invention as specified in claim 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Haskins can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
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Art Unit 2625

MRM

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